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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,047	06/25/2002	Jerry Pelletier	Goudreau	2183
	7590 09/09/2003			
Gladys H Monroy Morrison & Foerster 755 Page Mill Road			EXAMINER	
			LU, FRANK WEI MIN	
Palo Alto, CA 94304-1018			ART UNIT	PAPER NUMBER
			1634	
			DATE MAILED: 09/09/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
	09/807,047	PELLETIER ET AL.				
Office Action Summary						
<b>,</b>	Examin r	Art Unit				
Th MAILING DATE of this communication app	Frank W Lu  ars on the cover sheet with the	1634 correspond nc address				
Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period of - Failure to reply within the set or extended period for reply will, by statute, - Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).  Status	36(a). In no event, however, may a reply be ting within the statutory minimum of thirty (30) day will apply and will expire StX (6) MONTHS from cause the application to become ABANDONE	mely filed ys will be considered timely. n the mailing date of this communication. ED (35 U.S.C.§ 133).				
1) Responsive to communication(s) filed on <u>06 April 2002</u> .						
2a) ☐ This action is <b>FINAL</b> . 2b) ☑ Thi	is action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims  4) Claim(s) 4.26 in/ore pending in the application						
4) Claim(s) 1-36 is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.  5) Claim(s) is/are allowed.						
6) Claim(s) is/are rejected.						
7) Claim(s) is/are rejected.						
8) Claim(s) 1-36 are subjected to:						
Application Papers						
9)☐ The specification is objected to by the Examiner.						
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.						
If approved, corrected drawings are required in reply to this Office action.						
12)⊡ The oath or declaration is objected to by the Examiner.						
Priority under 35 U.S.C. §§ 119 and 120						
13)⊠ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ⊠ None of:						
1 🛛 Certified copies of the priority documents	1. Certified copies of the priority documents have been received.					
2. Certified copies of the priority documents	2. Certified copies of the priority documents have been received in Application No					
<ul> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>						
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).						
a) ☐ The translation of the foreign language pro 15)☐ Acknowledgment is made of a claim for domesti	visional application has been red	ceived.				
Attachment(s)						
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Informal	y (PTO-413) Paper No(s) Patent Application (PTO-152)				

## **DETAILED ACTION**

## **Election of Species**

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- (1) use of a modified olig d(T) homopolymer during first strand synthesis
- (2) use of a modified olig d(T) homopolymer during second strand synthesis

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Species (1) is claims 5-14

Species (2) is claim 36

The following claim(s) are generic claims 1-4 and 15-35.

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The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because use of a modified olig d(T) homopolymer during first strand synthesis in species (1) is not required for species (2) while use of a modified olig d(T) homopolymer during second strand synthesis in species (2) is not required for species (1)

2. This application also contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- (3) a method for reducing mispriming during 5' RACE
- (4) a method for reducing mispriming during 3' RACE

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Species (3) is claims 20-28

Species (4) is claims 29 and 30

The following claim(s) are generic claims are claims 1-19 and 31-36.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because 5' RACE in species (3) is not required for species (4) while 3' RACE in species (4) is not required for species (3).

## **Priority**

- 5. The examiner notes that applicant has filed a priority document. However, this is no certified copy of Canada patent application 2,246,623 in this instant application, which is required by 35 U.S.C. 119(b).
- 6. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG

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94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-1237.

Frank Lu

September 5, 2003